

REMARKS

Reconsideration and further examination of the subject patent application in light of the present Amendment and Remarks is respectfully requested. Claims 1-58 are currently pending in the application. Claims 1-58 stand rejected.

Claim Objection

Claim 50 has been objected to. In response, claim 50 has been corrected as suggested.

Rejections Under 35 U.S.C. §112

Claims 1, 17, 18, 28, 29 and 50 have rejected under 35 U.S.C. §112, second paragraph. In particular, the Office Action asserts that the word “governmentally” should be deleted from the phrase “governmentally recognized not-for-profit.” In response, the word has been deleted.

Rejection Under 35 U.S.C. §103

Claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. Publ. No. US 2002/0188532 to Rothstein. Applicant respectfully traverses these rejections.

In this regard, the Office Action asserts that “As per claims 1-9, 12-15, 16-27, 28-37, 40-49 and 50-58, Rothstein discloses an apparatus and method for advertising in

electronic books (ad books)” (Office Action of 12/22/08, page 7). However, the comparison of Rothstein with the claimed “ad book” is speculative at best.

On a first level, Rothstein explicitly states that the Rothstein “invention is a computer-implemented method for advertising in electronic books” (Rothstein, par. [0006]). However, an ad book does not constitute advertising in an electronic book. Instead, the ads in an ad book are (for all practical purposes) the book.

In another regard, “an electronic book 114 is received from a publisher 104 by a distributor 106 . . . collects electronic ads 112 from advertisers 102 and converts the electronic ads to the format of the electronic book 112 before insertion into the electronic book” (Rothstein, par. [0023]). In contrast, ad books do not use electronic content from publishers or combine electronic content from publishers with content from contributors.

It appears that the Office Action simply assumes that if a book contains ads, then (ergo) it must be an ad book. However, this assumption clearly misunderstands the conventional meaning in the art of the term “ad book.”

Moreover, independent claims 1, 28, 29, and 50 are not drawn simply to “ad books.” Instead, independent claims 1, 28, 29 and 50 are limited to “ad books . . . used by or for a recognized not-for-profit organization.”

At least one expert in the field, Mr. Lewis Saltzman, asserts that an “ad book” is “a term for a charity or not-for-profit publication, such as [an] event program or honorarium, mostly filled with laudable statements by members and supporters of a group directed to the members and supporters of the group” (Affidavit of Lewis Saltzman, par. 3, attached). As such, the term “ad book” and especially, an ad book used

by a not-for-profit organization has a very different meaning and is structurally and functionally different than the electronic book of Rothstein.

Moreover, Mr. Saltzman asserts that “I have found that the ‘ad books’ are not in the same nature as a book or novel, nor [do] they seek to insert ads or advertisements into a previously published book, work of fiction or non-fiction or any other sort of novel or book” (Affidavit of Lewis Saltzman, par. 15). As such, an ad book is clearly different than the enhanced electronic publication of Rothstein.

With regard to the affiant, Mr. Saltzman has “been involved in the business of printing including the pre-print, producing and printing of charity and not-for-profit ‘ad books’ and similar directories and event programs since about the year 1951” (Affidavit of Lewis Saltzman, par. 2). Mr. Saltzman is President of Saltzman Printers Inc. In addition, “Saltzman Printers, Inc. was established around 1946 and incorporated in about 1955 and has been producing ‘ad books as a significant part of its business continuously since that time” (Affidavit of Lewis Saltzman, par. 6). Mr. Saltzman asserts that “I and my family were instrumental in the earliest applications of ‘charity ad-books’ for group fund raising” (Affidavit of Lewis Saltzman, par. 8). Because of Mr. Saltzman’s experience in the printing industry and in the publication of ad books in general, Mr. Saltzman is an expert in the field of ad books (Affidavit of Lewis Saltzman, par. 17).

Moreover, those of skill in the art would not confuse the term “ad book” with the electronic book of Rothstein, with commercial publications or the use of advertising within those publications. In this regard, Mr. Saltzman asserts that “As one skilled in the art [of] publishing and printing of all kinds, including both books and ‘ad-books’, I do not believe that an electronic book, or book converted to an electronic format is remotely

related to an 'ad-book . . . I do not believe that they could be confused, nor that the concepts which could be described in an electronic book lead to any of the concepts of the ad-book as set forth in this declaration or in the pending patent by Bruce A. Fogelson" (Affidavit of Lewis Saltzman, par. 20).

On another level, the "ads" of an ad book would not be confused with commercial advertising. On a first level, the "ads" of an ad book are mostly laudable statements. On another level, the "ads" of the ad book constitute "most" of the ad book.

Mr. Gerald Fogelson asserts that "an 'ad book' is similar in nature to other such charity books, directories and guide books used for fundraising for local not-for-profit groups parties or associations as a way to help raise money from members and affiliates for the not-for-profit purposes of the group as opposed to a publication with the sole commercial advertising decisions for such other books, such as coupon-books, or trade journals or such general publications as newspapers" (Affidavit of Mr. Gerald W. Fogelson, par. 9, attached). Ms. Lori Fogelson asserts that "I am . . . very familiar with the term 'ad-book' which I take to mean a book or collection of donations which sponsor or feature congratulations, praise, and or similar laudable statements for a given charity or not-for-profit group . . . [The] general term 'ad-book' I have taken to mean the type of 'book' or collection of donation or charitable statements or 'ads' within the not-for-profit world, and not, by contrast any commercial or advertising book" (Affidavit of Lori O. Fogelson, par. 4, attached).

With regard to commercial advertising in general, Mr. Fogelson asserts that "I consider the commercial message, production value, image, and the value of the exposure that my advertising will have to potential target market of customers as an important

factor in placing advertisements” (Affidavit of Bruce A. Fogelson, par. 11). In contrast, Mr Saltzman asserts that “I have found that many ‘ad’ buyers for messages in ‘ad books’ do so simply desire to see their message or names in print before the group in exchange for their contribution, and seemingly have no commercial or advertising purpose” (Affidavit of Lewis Saltzman, par. 18). Mr. Fogelson asserts that “donors to ‘charity ad books’ have a similar donor’s intent to one who would donate money to a contribution building fund of a not-for-profit school, hospital, library or institution to gain the recognition of having [] their name [] in or on the new building on a plaque brick or the major naming rights of naming the entire wing or building after the donor” (Affidavit of Gerald W. Fogelson, par. 11).

In addition to having a different structure and content, ad books are also used for a different purpose and in a different way than the electronic books of Rothstein. In this regard, Mr. Saltzman asserts that “I have found that ads placed in ad books is not the same or equivalent to commercial advertising because of the differences in the content of the ad books and also because of the way that ad books are solicited, promoted or ‘sold” (Affidavit of Lewis Saltzman, par. 19). Mr. Fogelson asserts that “I can attest that the majority, if not the vast majority of ‘ads’ in the ‘ad-books’ I am familiar with seem to me to be by people and companies or anonymously who placed these ads in the ad-book with the knowing intent that the ‘ads’ or messages were for not-for-profit, charity or political purposes and that these donor/advertisers were not solicited from the general public, but were members, sponsors or supporters of the group or groups members or affiliates who were solicited from the group” (Affidavit of Gerald W. Fogelson, par. 20).

For example, Exhibit C of the Affidavit of Gerald W. Fogelson is a typical Program Ad Contract used by Roosevelt University Chicago School of Real Estate where Mr. Fogelson is a member of the board of directors (Affidavit of Gerald W. Fogelson, par. 16). In this regard, the Program Ad Contract states that "The full amount of your contribution is tax deductible" (Affidavit of Gerald W. Fogelson, Exhibit C). Mr. Fogelson asserts that "This statement is . . . relevant since the Program Book is not a general publication and reaches only those member of the group which are already donating to the event by attending and thus already members or affiliates, there is no commercial publication and thus no real val[u]e in relation to their cost or for any of the ads as compared to a commercial publication in a general or trade publication" (Affidavit of Gerald W. Fogelson, par. 18).

Mr. Saltzman asserts that "I have found that 'ad books' are produced by group volunteers who produce the ad book without pay. These group volunteers are not professionals either to the printing nor publishing nor advertising business and have tremendous turnover within the group and most, if not all, have little working knowledge of the 'Ad Book' process or of any commercial or non-commercial printing or publishing" (Affidavit of Lewis Saltzman, par. 13). Mr. Saltzman also asserts that "I have found that the volunteers who produce ad books usually have very little or no experience in commercial advertising and the vast majority of the 'ad-books' ads are not of the type or nature of a commercial advertisement" (Affidavit of Lewis Saltzman, par. 14). As such, a person of skill in the art of ad books would have minimal computer experience and very little or no advertising experience.

Mr. Saltzman also asserts that “I have found that the ‘ads’ or laudable statements that are solicited for ‘ad books’ are recorded manually on forms typical for that purpose and taken by the volunteers onto paper forms, which then need to be pre-print processed into ‘ads’ or messages suitable for pagination and printing. Other than the proposed invention by Bruce A. Fogelson, I have never seen an electronic or automated form that can expedite this for process, either for the group soliciting or for a printer, such as us. This invention would represent a novel and useful tool to my view as an expert in the field” (Affidavit of Lewis Saltzman, par. 17). As such, the prior art has taught away from the claimed invention.

Moreover, there has been a long-felt need for a better method of producing ad books. For example, “Even as technology has advanced in the printing industry, it is my professional opinion, that the ‘ad book’ type pre-print and production and the charity methods solicitations of such laudable statements and the overall concepts has remained the same, with no significant change, and has lagged frustratingly behind, both as a way for an organization raise money for its cause and as a way for an organization to provide better pre-print production or printing . . . The exception to this is my introduction to the ‘Ad Book process . . . by Bruce A. Fogelson in 2006” (Affidavit of Lewis Saltzman, par. 11).

As set forth above, Rothstein fails to provide any teaching or suggestion of an ad book. As noted above, a person of skill in the art would not confuse a Rothstein publication with an ad book.

Moreover, a contributor to an ad book is motivated by entirely different reasons than an advertiser in a Rothstein type publication. The Rothstein advertiser is motivated by profit and the contributor is motivated by charity and/or a need for recognition.

Since the Affidavits establish that the electronic books of Rothstein are structurally and functionally different than that of the claimed invention, the rejections are improper. Since the rejections are improper, they should be withdrawn.

The Office Action asserts ("Official Notice") that "Street News" is a local publication published by an organization in New York on behalf of the homeless . . . The organization solicits and receives ads from advertisers or supporters, supporting the Homeless cause, and the advertisers' messages are placed or displayed in the newspapers that is distributed and sold to the public at large and the advertisers or supported are billed for placing their ads in the newspaper (receiving a pledge or contribution from a supporter or advertiser for agreeing to place an ad in the "Street News" newspaper or ad-book" (Office Action of 12/22/08, page 9). The difficulty with this assertion however is that there is no identifiable organization (other than the newspaper) that solicits the ads and it appears that the solicitation is, in fact, by the newspaper on a for-profit basis. If the Examiner believes otherwise, then the Examiner should cite a reference or other publication (as required) that establishes such facts.

The Office Action makes vague reference to "Special" cards to raise funds for the needed. However, such references appear to be completely without basis. If the Examiner believes that these references teach some aspect of an ad book, then the Examiner should cite a reference or other publication (as required) that establishes such facts.

The Office Action makes reference (page 10) to church bulletins (e.g., Holy Name Church, located in New York City) that have displayed in the back portions announcements and advertisements on behalf of local advertisers or supporters for an advertising fee and the revenues raised through this process help cover the churches overhead cost. However, once more, there is no basis for these assertions. Do the bulletins contain mostly laudatory statements? Are they distributed at some event? If the Examiner believes that these are ad books, then the Examiner should cite a reference or other publication (as required) that establishes such facts.

The Office Action assert that it is common practice to download tools to create advertisements. However, these statements are without basis. If the Examiner believes otherwise, then the Examiner should cite a reference or other publication (as required) that establishes such facts.

For any of the above reasons, the claimed ad book would not be obvious in view of Rothstein. Since the claimed ad book would not be obvious, the rejections are improper and should be withdrawn.

Closing Remarks

Allowance of claims 1-58, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

The Commissioner is hereby authorized to charge any additional fee which may

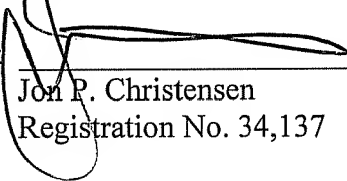
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be required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920.

Respectfully submitted:

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